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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,740	01/25/2007	Martial Deruelle	1004900-000279	6000

21839 7590 03/03/2010
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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03/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
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Office Action Summary	Application No. 10/586,740	Applicant(s) DERUELLE ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/25/09 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35, 37-39 and 41-48 is/are rejected.
- 7) ☒ Claim(s) 36-38, 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed November 25, 2009 is acknowledged. Claims 1-22 are deleted. Claims 23-48 are amended. Now, Claims 23-48 are pending.
2. Claim objection(s) in the previous Office Action (Paper No. 10586740) is/are removed.
3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 10586740) is/are removed.
4. Claim rejection(s) under 35 USC 103 in the previous Office Action (Paper No. 10586740) is/are removed.
5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Objections

6. Claims 37-38 are objected to because of the following informalities:
Appropriate correction is required.

In Claim 37 (line 4), should “constituent B-2” be -- constituent --?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. Claims 23-35, 37-38, 41 and 44-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zotto (US 4 781 973).

Zotto discloses a method of treating a textile material employing a composition comprising a) an MQ or MDQ resin, b) an alkylalkoxypolysiloxane resin containing Q units, c) a condensation catalyst, such as tetrabutyltitanate, zirconium octoate, etc. and optionally an alkoxy crosslinking agent. (col. 1, line 61 to col. 2, line 21, col. 3, line 52 to col. 4, line 28 and Examples) Component a) can contain hydroxy or

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alkoxy groups. (col. 2, lines 46-55) The alkoxy crosslinking agent can be methyltrimethoxysilane, etc. (col. 3, lines 3-12 and col. 5, lines 7-42)

Perfluoroalkyl-containing alcohols can be used. (col. 5, lines 5, lines 43-68)

The amounts of component b) and component c) are described in col. 3, lines 36-43, col. 4, lines 9-15. Since Zotto discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02. The composition can be diluted with a solvent. (col. 5, lines 32-42)

4. Claims 23-35, 37-39 and 44-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ona (EP 506 113).

Ona discloses a method of treating a textile material employing a composition comprising components A) to E). (page 2, lines 30-52)

Component B) can be end-capped with hydroxyl groups. (page 3, lines 32-39) Since Ona discloses all the limitations of a claim except a property or

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function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02.

5. Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zotto.

Zotto discloses a method of treating a textile material utilizing a perfluoroalkyl-containing alcohol, *supra*, which is incorporated herein by reference. Zotto is silent on the claimed length of the perfluoroalkyl radical. However, Zotto teaches that the perfluoroalkyl-containing alcohol can impart oil resistance and water repellency to the coated substrate. (col. 5, lines 43-68) As such, the length of the perfluoroalkyl radical would affect the properties of the substrate. In other words, the length of the perfluoroalkyl radical is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an alcohol having whatever length of the perfluoroalkyl radical through routine experimentation in order to afford a composition to

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impart desired properties of the coated substrate. Especially, Applicants do not show the criticality of the length of the perfluoroalkyl radical. See MPEP 2144.05 (II).

6. Claims 36 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private

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PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
February 23, 2010

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796